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Response to Office Action Dated 01/13/2004

REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 01/13/2004 Office Action.

In the Claims:

Claims 1—19 were originally filed.

No claims are canceled.

No are added.

Claim 7 was amended.

Accordingly, claims 1—19 are pending.

Traversal of Finality of the Rejection

The Applicant argues that in the 01/13/2004 Office Action the Patent Office made a final rejection which was inappropriate. In summary, the Patent Office indicated that the Applicant's amendments necessitated the new grounds for rejection. However, several of the Applicant's claims were never amended, and are now rejected on new grounds, using new art. Accordingly, the Applicant respectfully requests that the finality of the rejection be removed.

In one example: In the Office Action mailed 07/02/2003 independent claims 11 and 15 and dependent claim 16 were rejected with a section 103(a) argument citing Mooney in view of Hayes. The claims were not amended in response to the rejection; in fact, these claims are still "Original," never having been amended. However, claims 11, 15 and 16 currently stand rejected under a new section 103 argument, based on a newly cited reference—Harari—in view of Hayes. Harari is newly cited art, having not been of record prior to the 01/13/2004

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1 Office Action. Thus, an improper final rejection was made. Accordingly, the
2 Applicant respectfully requests that the finality be removed.

3
4 **Section 102 Rejection of the Claims**

5 Claims 1, 7 and 17 are rejected under 35 U.S.C. §102(e) as being
6 anticipated by U.S. Patent No. 5,887,145, hereafter "Harari". The Applicants
7 respectfully traverse the rejection and further request that the rejection be
8 reconsidered and withdrawn.

9 Harari relates to a personal computer ("PC") card having a PCMCIA form-
10 factor PC mother card portion (col. 6, lines 63—67), which can be mated with an
11 EEPROM memory chip daughter card (col. 7, lines 4—6 and 31—32).

12 Claim 1 recites a system comprising "a profile carrier, removably
13 connectable to a computer, comprising: a memory device to store the user data;
14 and a smart card associated with a user that alternately enables access to the user
15 data on the memory device when both the memory device and smart card are
16 interfaced with a common computer and disables access to the user data when one
17 of the memory device or smart card is absent." Similarly, claims 7 and 17 both
18 disclose a memory device and a smart card.

19 The Harari reference fails to anticipate the claimed invention by failing to
20 teach each and every feature of the claim, as required by MPEP 2131. More
21 specifically, the rejection suggests that Harari discloses a smart card. However,
22 Harari actually discloses a PCMCIA form-factor PC card—which fails to perform
23 the typical smart card functionality recited in claim 1 (and claim 7, as amended).
24 In particular, the PC mother card of Harari fails to perform user identification
25 and/or verification. What Harari does do is to provide a secret key on the daughter

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1 board (the memory device) (see col. 13, line 67 to col. 14, line 3). However,
2 Harari does not associate the mother card "with a user," as seen in the Applicant's
3 claims. Instead of associating the mother card with a user, Harari controls the
4 operation of the daughter card to function only with certain host systems (col. 14,
5 lines 20—22).

6 The Applicant's claims are distinguished from the Harari disclosure in that
7 the smart card of claims 1 and 7 are "associated with a user". From a practical
8 perspective, this association provides evidence (in a system according to the
9 Applicant's claims 1 and 7) that the user actually is the user (not an imposter).
10 Thus, in claim 1 the smart card is "associated with the user" and thereby provides
11 a user-identification function, wherein the user is provided access to the user data
12 when the user's ID is verified by presentation of the smart card.

13 Thus, claims 1 and 7 are not properly rejected by the Harari reference,
14 which fails to disclose *an actual smart card* which is "associated with a user."
15 Accordingly, the section 102 rejection of claims 1 and 7 is properly removed.

16 With respect to claim 17, the Patent Office suggests that col. 13, line 63 to
17 col. 14, line 7 of Harari discloses "reading the access credentials from the smart
18 card to enable access to the user data on the portable memory device", as recited
19 by the Applicant's claim 17. The Applicant respectfully disagrees, and notes that
20 Harari actually states that "a secret key can be encoded on the daughter card that
21 allows it to communicate with designated host systems or mother cards only."
22 (col. 13, line 67 to col. 14, line 3).

23 Thus, in Harari, "the access credentials" and "the memory" are based on a
24 single device—the daughter card. This is in contrast to the recitations of claim 17,
25 wherein "storing access credentials on the smart card" and also enabling "access to

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1 the user data on the portable memory device" indicate method steps involving two
2 devices: i.e. "the smart card" and "the portable memory device". Thus, Harari
3 combines the "access credentials" and "memory" on one device (the daughter
4 card); in contrast, the claim recites two devices: access credentials on the smart
5 card; and, user data on a memory device.

6 Accordingly, it is respectfully submitted that, for at least the reasons set
7 forth above, the Harari reference fails to teach all of the features presently
8 claimed, and thus the rejection under 35 U.S.C. §102(b) should be withdrawn.

9
10 **Section 103 Rejection of the Claims**

11 Claims 2, 11, 15 and 16 were rejected under §103(a) as being unpatentable
12 over Harari in view of published application number 20010011341, herein after
13 "Hayes". The Applicant respectfully traverses the rejection.

14 Claim 2 recites "wherein the memory device stores a user's profile that can
15 be used to configure a computer", and claims 11, 15 and 16 recite a similar
16 limitation. The Patent Office cites Hayes as an example of a user profile that is
17 kept on a computer. The Patent Office further suggests that it would have been
18 obvious to put the user profile of Hayes on the portable memory of Harari. The
19 Applicant respectfully disagrees.

20 It would not have been obvious to combine Hayes with Harari, in part
21 because Hayes teaches centralization of data, and teaches away from the need to
22 allow personal data on personally possessed portable memory devices. Using the
23 passage cited by the Patent Office at page 1, paragraph 4, it is seen that Hayes
24 discloses "an administrator" creating user profiles stored on "a network server".
25 Thus, we see that Hayes teaches away from an environment wherein the user has

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1 access to the user's own profile on a memory device "to configure a computer"
2 (claim 2). In fact, Hayes teaches a client-server environment, wherein a user's
3 profile is not even stored on the user's own (client) computer, but are in fact stored
4 remotely, on the network server. Thus, Hayes teaches *centralization*, by putting
5 the client's profiles in a central location, not on their own computer. Claim 2, in
6 contrast, teaches *decentralization*, wherein the user's data is stored on the memory
7 device which is "portable" (claim 11). Thus, Hayes facilitates an environment
8 wherein everyone's profile is centrally located; the Applicant's claims facilitate an
9 environment wherein everyone's profile may be stored on their own portable
10 memory device.

11 Second, it would not have been obvious to combine Hayes and Harari
12 because Hayes teaches the use of the network to set up the user's profile and
13 desktop (0011). Since Hayes *teaches his own solution* to setting up profiles on a
14 computer wherein a profile for the user does not yet exist (by using a network),
15 *there is nothing to motivate Hayes to discard his system and instead to try to adapt*
16 *Harari's teachings* (by using a memory device). It would not benefit Hayes to so
17 fundamentally change the Hayes invention and teachings, given the Hayes goal of
18 using a network to reconfigure computers on the network. Note in 0011, Hayes
19 discloses that users may "roam" to a new computer, and using the Hayes system to
20 configure (over the network) the new computer to look like their preferred
21 computer. Thus, Hayes teaches the use of a network to move user data, not a
22 portable device, as recited in claim 11. The combination suggested by the Patent
23 Office would essentially "gut" the Hayes invention, by dispensing with the server-
24 client model taught by Hayes.

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1 For these reasons and others—particularly those seen in the discussion of
2 claim 1 which apply to claim 11—the 103(a) rejection of claims 2, 11, 15 and 16
3 should be removed. The Applicant respectfully requests that this be done.

4 Claims 3, 8 and 17 were rejected under §103(a) as being unpatentable over
5 Harari in view of U.S. Patent No. 5,594,227 herein after “Deo”. The Applicant
6 respectfully traverses the rejection.

7 The combination of Harari and Deo would be non-obvious. This is true for
8 several reasons, including the fact that Harari is configured to use encryption (col.
9 14, lines 3—7). Harari already has several components: a host, a mother card, and
10 a daughter card. Harari has already protected the data using strong encryption.
11 The addition of a smart card reader and a smart card to the Harari system would be
12 unwieldy, and would result in less utility in that not all potential hosts would have
13 a smart card reader.

14 Harari’s use of encryption teaches away from the addition of a passcode to
15 his mother/daughter card combination. Having made provisions for the use of
16 encryption, it is unclear what would motivate Harari to use Deo’s passcode. The
17 Patent Office states that the motivation would be due to: “the smart cards can
18 perform password verification off-line without connection to a back end computer
19 and are self-validating with the access security code resident thereon”. However,
20 Harari has shown that he believed that encryption was suited to his application by
21 disclosing it (top of col. 14). The Patent Office has not shown what would
22 motivate Harari to want to perform password verification—particularly in light of
23 the strong encryption that was provided.

24 The Patent Office’s argument that Harari could incorporate Deo’s smart
25 card and passcode into the Harari system is inconsistent with the Patent Office’s

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1 argument in rejecting claim 1, wherein the Patent Office indicated that the mother
2 card was the smart card and that the daughter card was the memory device. If that
3 were true, then Harari would not think that it was obvious to add what he already
4 had. The Applicant notes that there are significant differences between the
5 Applicant's claims and the Harari system, and that it would not have been obvious
6 for Harari to incorporate Deo's teachings, since Harari had already solved his
7 security issues with strong encryption.

8 As a result, due in part to Harari's lack of an actual smart card, also and due
9 to inapplicability of the Patent Office's argument for combining Harari with Deo
10 in light of Harari's strong encryption solution, the Applicant respectfully requests
11 that the section 103(a) rejection be withdrawn.

12 **Claims 4 and 9** were rejected under §103(a) as being unpatentable over
13 Harari in view of U.S. Patent No. 5,623,637, herein after "Jones". The Applicant
14 respectfully traverses the rejection. Claims 4 and 9 depend from claims which are
15 allowable for the reasons seen above. Accordingly, claims 4 and 9 are allowable
16 for this reason, as well as for reasons associated with the elements recited by each
17 claim.

18 **Claim 10** was rejected under §103(a) as being unpatentable over Harari in
19 view of Deo and Jones. The Applicant respectfully traverses the rejection.

20 Claim 10 depends from claim 7 and is allowable by virtue of that
21 dependence, as well as for reasons associated with the elements recited.

22 **Claim 14** was rejected under §103(a) as being unpatentable Harari, Hayes,
23 Deo and Jones. The Applicant respectfully traverses the rejection. In general,
24 claim 14 is allowable for the same reasons as claim 10. Moreover, the Applicant
25 further points out that where four (4) references are required, as seen above, that

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1 number of references, in and of itself, indicates that it would not have been
2 obvious to select and combine so many references: Accordingly, claim 14 is
3 allowable, and the Applicant respectfully requests removal of the rejection.

4 **Claims 5 and 6** were rejected under §103(a) as being unpatentable Harari,
5 Hayes, Deo and Jones. The Applicant respectfully traverses the rejection.

6 These claims are allowable for reasons similar to the argument seen above
7 with respect to claim 1. Additionally, the Applicant points out that where it takes
8 *four* references to disclose the elements of the Applicant's claims, that in itself
9 argues for the non-obviousness of the claims. However, Claims 5 and 6 are both
10 disclose a "profile carrier" having "smart card" and having a "memory device,"
11 wherein the profile carrier with its two recited components can be "interfaced to" a
12 common computing unit. None of the references show such an arrangement,
13 wherein the two devices, the smart card and the memory device, are grouped to
14 form a "profile carrier," and are interfaced to a computer. For example, as we
15 have seen above, Harari does not show a smart card, but instead shows a PCMCIA
16 card. Moreover, none of the references suggest such an arrangement, wherein a
17 profile carrier acts as a means to "permit access to the user profile stored on the
18 memory device" (claim 5). Accordingly, claims 5 and 6 are allowable, and the
19 Applicant respectfully requests removal of the rejection.

20 **Claim 18** was rejected under §103(a) as being unpatentable Harari in view
21 of Hayes, Deo and Jones, Sigbjornsen and Kutler. The Applicant respectfully
22 traverses the rejection.

23 Claim 18 is allowable for many of the same reasons claim 1 is allowable,
24 noted above. Moreover, the Applicant again notes the quantity of references,
25 which had to be discovered to find the elements of the Applicant's claim, indicates

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1 that the claim is actually non-obvious. Further, the Applicant notes—as seen
2 above—that even combined the references do not show both “interfacing the smart
3 card with a computer” and also “interfacing the portable memory device with the
4 computer”. This combination of devices, interfaced to the computer, is not seen,
5 particularly for the purposes recited in the method, wherein access to the user data
6 stored in the memory device is obtained after authentication takes place at the
7 smart card. In view of the above, and in view of arguments previously expressed,
8 the Applicant respectfully requests that the §103(a) rejections be withdrawn.

9 **Claim 19** rejected under §103(a) as being unpatentable Harari in view of
10 Hayes, Deo and Jones. The Applicant respectfully traverses the rejection.

11 **Claim 19** is allowable for many of the same reasons claim 1 is allowable,
12 noted above. Additionally, claim 19 is allowable for the reasons seen above,
13 wherein the references cited do not disclose a “smart card secured profile carrier
14 having memory to store a user profile and a smart card separate from the
15 memory”, as recited by claim 19. Accordingly, the software of claim 19, which
16 interfaces with the “secured profile carrier” having smart card and separate
17 memory, is not seen in the prior art of record. Such software cannot exist, where
18 the structure to which it interfaces is not known.

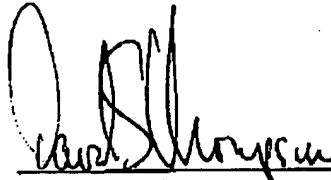
19 **Conclusion**

20 **Claims 1—19** are in believed to be in condition for allowance. Applicant
21 respectfully requests reconsideration and prompt issuance of the present
22 application. Should any issue remain that prevents immediate issuance of the
23 application, the Examiner is encouraged to contact the undersigned attorney to
24 discuss the unresolved issue.
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